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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------|-------------|----------------------|----------------------|------------------|
| 10/667,353 | 09/23/2003 | Michael J. Cleary | JPC-010 | 3390 |
| 70813 | 7590 | 07/09/2010 | EXAMINER | |
| GOODWIN PROCTER LLP | | | SHRESTHA, BIJENDRA K | |
| 901 NEW YORK AVENUE, N.W. | | | | |
| WASHINGTON, DC 20001 | | | ART UNIT | PAPER NUMBER |
| | | | 3691 | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 07/09/2010 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/667,353 | CLEARY ET AL. | |
| | Examiner | Art Unit | |
| | BIJENDRA K. SHRESTHA | 3691 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 21 June 2010.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-36 and 41 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-36 and 41 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

This Non-Final Office action is in response to Request for Continued Examination (RCE) filed on June 21, 2010 which includes amendment to claims 1, 17, 27 and 41. Claims 1-36 and 41 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/21/2010 has been entered.

Information Disclosure Statement

The Applicant is requested to provide references relevant to the art of the instant application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 15-17, 23 and 27-36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 41-42, 45-51, 57-58, 62 and 73-75 of copending Application No. 11/780,930. Although the conflicting claims are not identical, they are not patentably distinct from each other because '930 application in claims 41-42, 45-51, 57-58, 62 and 73-75 teaches all the elements in claims 1, 15-17, 23 and 27-36 in the instant application.

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

As per claims 1, 15-17 and 27-30 of instant application, claims 41-42, 50-51, 57-58, 62 and 73-74 of application '930 teaches issuing inactive/dead credit and/or debit card and activating the card by funding the account with a customer supplied source of funds

As per claims 23 and 31-36 of instant application, claims 45-49 and 75 of application '930 teaches incentives, rewards and rebates provided to a customer to accept the new card distributed by the bank.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 1, 17 and 27 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The amendment to the claims 1, 17 and 27 includes limitation “an unsolicited dead bank card associated with an inactive bank deposit account”. The Examiner reviewed the written description and unable to find support of “inactive deposit account”. The best related phrase in the written description are “bank account that was previously closed with that bank” (page 3, lines 13-14), “past bank account” (Fig. 2, 214; page 11, line 10). Applicant is request any portion of specification where “inactive deposit account” is cited in response to this office action.

Examiner interpreted “inactive deposit account” as “past bank account” for prosecution of this application.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. *Claims 1-22, 24-26 and 41 are rejected under 35 U.S.C. 103 (a)) as being unpatentable by Melchione et al. U.S. Patent No. 5,930,764 (reference A in attached*

PTO-892) in view of Walker et al., U.S. Pub No. 2008/0052225 (reference B in attached PTO-892) further in view of Nabe et al., U.S. Patent No.7,305,364 (reference C in attached PTO-892).

3. As per claim 1, Melchione et al. teach a method for distributing bank cards, comprising:

identifying a pool of potential new bank account holders for a bank (see Fig. 1; column 1, line 29; column 27, lines 32-43; 41-48; where customer Leads from Micro-marketing Center (11) fed to Central Database (10) which ultimately led to Business Feed (22) which include different services provided by the bank such as shown Fig. 13A);

determining if a person from the pool is an existing bank account holder (see Fig. 1; Fig. 10 A and 10 B; column 44, lines 10-14; where sales leads from Micro-marketing Center segregated into new customer and existing customer based on information entered to identify customer and the sales campaign (Fig. 8C));

determining whether the person is eligible for opening a new bank account if the person is not an existing bank account holder (see Fig. 6B; Fig. 10B);

creating *an unsolicited* bank card including embossed information and magnetic stripe information (see Fig. 16A; column 55, lines 34-43).

Melchione et al. do not teach a dead bank card associated with an inactive bank account, and distributing the dead bank card to the person.

Walker et al. teach a dead bank card associated with an inactive bank account, and distributing the dead bank card to the person (Walker et al., abstract; Fig. 5A-5C,

steps 560-575, paragraph [0050-0051]; where dead bank card or inactive card unsolicited by a customer transmitted to sponsoring organization (step 560)and offered to customer upon arrival at sponsoring organization, such as hotel (step 570); the credit account is inactive, account is activated only after accepted by the customer (Step 575 - 585), credit card is destroyed if the consumer declines the offer (step 575 – 580)).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include a dead bank card associated with an inactive bank account, and distributing the dead bank card to the person of Melchione et al. because Walker et al. teach including above features enables to encourage consumer to utilize new credit card (dead card) by instantly issuing and activating a new card as part of a chargeable event (Walker et al., paragraph [0011]).

Melchione et al. do not teach selling (or issuing credit card) to inactive customer.

Nabe et al. teach selling to inactive customer base (see Fig. 4, Inactive auto Finance Customer Base (120)).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include selling to inactive customer base of Melchione et al. because Nabe et al. teach including above features enables one or more inactive customer respond to offer to sell (Nabe et al., column 1, lines 34-35).

4. As per claim 2, Melchione et al. in view of Walker et al. teach claim 1 as described above. Melchione et al. further teach the method wherein

Melchione et al. do not teach the pool is identified based on the region or regions served by the bank issuing the new bank accounts.

Walker et al. teach the pool is identified based on the region or regions served by the bank issuing the new bank accounts (see (Walker et al., paragraph [0032]; where potential new account are identified through the routine hotel reservation process served by the issuing bank).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include the pool is identified based on the region or regions served by the bank issuing the new bank accounts of Melchione et al. because Walker et al. teach including above features enables to activate the issued credit card by the customer immediately at checking by providing some incentive/benefits (Walker et al., paragraph [0032]).

5. As per claim 3, Melchione et al. in view of Walker et al. teach claim 1 as described above. Melchione et al. further teach the method wherein the pool is identified based on individuals applying for new credit account (see Fig. 10 B).

6. As per claim 4-8, Melchione et al. in view of Walker et al. teach claim 1 as described above. Melchione et al. further teach the method wherein the pool is identified based on a life event comprising a move to a new residence, a marriage or divorce, a death of a partner or spouse, a birth or a new phone account (see Fig. 6C, Display Customer Needs and Notes Screen; column 1, lines 38-52; column 35, lines 51-57).

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7. As per claim 9, Melchione et al. in view of Walker et al. teach claim 1 as described above. Melchione et al. further teach the method including determining whether the person was a previous bank account holder (see Fig. 10A; where Greeter identify customer by reviewing the profile to prepare for session).

8. As per claim 10, Melchione et al. in view of Walker et al. teach claim 9 as described above. Melchione et al. further teach the method including determining why the person closed the previous bank account in the event the person was a previous bank account holder (see Fig. 10A; steps 200 and 300).

9. As per claim 11, Melchione et al. in view of Walker et al. teach claim 1 as described above. Melchione et al. further teach the method wherein the step of determining whether the person is eligible comprises evaluating credit score information supplied by a credit bureau (see 12 B-C; column 49, lines 53-67).

10. As per claim 12, Melchione et al. in view of Walker et al. teach claim 1 as described above. Melchione et al. further teach the method wherein the step of determining whether the person is eligible comprises determining whether the person is an existing or past credit card account holder with the bank (see Fig. 10 A and 10 B); and

evaluating the payment history if the person is an existing or past credit account holder (see Fig. 10A).

11. As per claim 13, Melchione et al. in view of Walker et al. teach claim 1 as described above. Melchione et al. further teach the method wherein

the step of determining whether the person is eligible comprises evaluating the age of the person (see Fig. 12; column 49, lines 17-25; where preliminary profile include collection of social security number and date of birth).

12. As per claim 14, Melchione et al. in view of Walker et al. teach claim 1 as described above. Melchione et al. further teach the method comprising

the step of prebuilding an account if the person is determined to be eligible, thereby permitting the bank to implement the new bank account quickly upon acceptance of the offer by the person (see column 7, lines 59-67 to column 8, lines 1-7; column 9, lines 53-64).

13. As per claim 15, Melchione et al. in view of Walker et al. teach claim 1 as described above. Melchione et al. further teach the method wherein

the bank card is a debit card or check card (see column 53, lines 32-42).

14. As per claim 16, Melchione et al. in view of Walker et al. teach claim 1 as described above. Melchione et al. further teach the method wherein

the bank card is an ATM card (column 35, lines 39; column 58, line 40).

15. As per claim 17, Melchione et al. teach a method of distributing bank cards, comprising:

receiving a customer application for a credit card to be issued by a bank (see Fig. 10A/10B; Fig. 13A; column 45, lines 1-9; where greeter identifies customer needs and receives information from credit card applicant);

processing the application to determine a decision on the credit card (see Fig. 13 A, H, K-M; Column 53, lines 7-20; column 54, lines 6-17);

determining whether the customer is an existing bank account holder of the bank (see Fig. 10A);

distributing a live credit card to the customer if the application is approved and the customer is an existing bank account holder (see Fig. 10A and 10 B; column 53, lines 22-42; where secured and unsecured credit card can be issued to existing and new account holder); and

Melchione et al. do not teach distributing *an unsolicited dead bank card associated with an inactive bank account to the customer if the application is approved and the customer is not an existing bank account holder.*

Walker et al. teach distributing *an unsolicited dead bank card associated with an inactive bank account to the customer if the application is approved and the customer is not an existing bank account holder* (Walker et al., abstract; Fig. 5A-5C, steps 560-575, paragraph [0050-0051]; where dead bank card or inactive card unsolicited by a customer transmitted to sponsoring organization (step 560) and offered to customer upon arrival at sponsoring organization, such as hotel (step 570); the credit account is inactive, account is activated only after accepted by the customer (Step 575 - 585), credit card is destroyed if the consumer declines the offer (step 575 – 580)).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include distributing *an unsolicited dead bank card associated with an inactive bank account to the customer if the application is approved and the*

customer is not an existing bank account holder of Melchione et al. because Walker et al. teach including above features enables to encourage consumer to utilize new credit card (dead card) by instantly issuing and activating a new card as part of a chargeable event (Walker et al., paragraph [0011]).

Melchione et al. do not teach selling (or issuing credit card) to inactive customer base.

Nabe et al. teach selling to inactive customer base (see Fig. 4, Inactive auto Finance Customer Base (120)).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include selling to inactive customer base of Melchione et al. because Nabe et al. teach including above features enables one or more inactive customer respond to offer to sell (Nabe et al., column 1, lines 34-35).

16. As per claim 18, Melchione et al. in view of Walker et al. teach claim 17 as described above. Melchione et al. further teach the method comprising

the step of determining if the customer is eligible to be a bank account holder of the bank (see Fig. 6B).

17. As per claim 19, Melchione et al. in view of Walker et al. teach claim 18 as described above. Melchione et al. further teach the method wherein

the step of determining if the customer is eligible comprises determining whether the customer resides within the bank account service footprint of the bank (see Fig. 6C; column 35; lines 49-57).

18. As per claim 20, Melchione et al. in view of Walker et al. teach claim 18 as described above. Melchione et al. further teach the method wherein the step of determining if the customer is eligible comprises performing a credit check or risk analysis supplemental to that performed for the credit card application (see Fig. 11C; Fig. 12B-C; column 49, lines 35-59).
19. As per claim 21, Melchione et al. in view of Walker et al. teach claim 17 as described above. Melchione et al. further teach the method comprising the step of determining whether the customer is a past bank account holder of the bank (see Fig.10A; where Greeter identify customer by reviewing the profile to prepare for session).
20. As per claim 22, Melchione et al. in view of Walker et al. teach claim 21 as described above. Melchione et al. further teach the method comprising determining the reason the past bank account was closed and evaluating the reason prior to the decision to distribute a dead bank card to the customer (see Fig. 10A/B; column 34, lines 20-39).
21. As per claim 24 -25, Melchione et al. in view of Walker et al. teach claim 17 as described above. Melchione et al. further teach the method wherein the live credit card and dead bank card are communicated to the customer in a single mailing or different mailings (see Fig. 16A; column 18-29; where bank issues different credit cards (secured and unsecured), mailing of which can be of together or separately).

22. As per claim 26, Melchione et al. in view of Walker et al. teach claim 17 as described above.

Melchione et al. do not teach prebuilding a new bank account for the customer prior to distributing the dead bank card.

Walker et al. teach prebuilding a new bank account for the customer prior to distributing the dead bank card (see Fig. 5A/5B).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include prebuilding a new bank account for the customer prior to distributing the dead bank card of Melchione et al. because Walker et al. teach including above features enables credit card issuer to instantly issue new credit card to credit qualified new customers (Walker et al., paragraph [0011]).

23. As per claim 41, Melchione et al. in view of Walker et al. teach claim 1 as described above.

Melchione et al. do not teach the method of distributing card comprises the recipient of the dead bank card opening the inactive account.

Walker et al. teach recipient of the dead bank card opening the inactive account (see Fig. 5C, paragraph [0050 - 0051]; where inactive account for a customer is established by a sponsoring organization such as hotel, which is activated only after the customer acceptance).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include the method of distributing card comprises the recipient of the dead bank card opening the inactive account of Melchione et al. because Walker et

al. teach including above features enables encourage consumer to utilize new credit card (dead card) by instantly issuing and activating a new card as part of a chargeable event (Walker et al., paragraph [0011]).

24. *Claims 27-32 are rejected under 35 U.S.C. 102 (e)) as being anticipated by Jones et al. U.S. Pub No. 2004/0117300 (reference D in attached PTO-892) in view of Walker et al., U.S. Pub No. 2008/0052225 (reference B in attached PTO-892) further in view of Nabe et al., U.S. Patent No.7,305,364 (reference C in attached PTO-892).*

25. As per claim 27, Jones et al. teach a method of distributing solicited credit cards and unsolicited bank cards, comprising:

receiving from a customer an application for a credit card to be issued by a bank (see Fig. 2A);

processing the application (see Fig. 2B);

determining if the customer is an existing bank account holder with the bank (see Fig. 5A, step 206);

distributing a live credit card to the customer if the application is approved and the customer is already an existing bank account holder (see Fig. 2B); and

distributing a live credit card to the customer if the application is approved and the customer is not an existing bank account holder (see Fig. 5A, step 206; where live card is issued to new customer subject to the customer activation in step 254 (Fig. 5B)).

Jones et al. do not teach distributing an unsolicited dead bank card associated with an inactive bank account to the customer if the application is approved and the

customer is not an existing bank account holder and processing a customer response to the dead bank card.

Walker et al. teach distributing *an unsolicited* dead bank card to the customer if the application is approved and the customer is not an existing *bank account* holder and processing a customer response to the dead bank card Walker et al., abstract; Fig. 5A-5C, steps 560-575, paragraph [0050-0051]; where dead bank card or inactive card unsolicited by a customer transmitted to sponsoring organization (step 560) and offered to customer upon arrival at sponsoring organization, such as hotel (step 570); the credit account is inactive, account is activated only after accepted by the customer (Step 575 - 585), credit card is destroyed if the consumer declines the offer (step 575 – 580)).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include distributing *an unsolicited* dead bank card to the customer if the application is approved and the customer is not an existing *bank account* holder and processing a customer response to the dead bank card of Jones et al. because Walker et al. teach including above features enables credit card issuer to instantly issue new credit card to credit qualified new customers and receive the credit card activation from the new customer as a part of a chargeable event (Walker et al., paragraph [0011]).

Melchione et al. do not teach selling (or issuing credit card) to inactive customer base.

Nabe et al. teach selling to inactive customer base (see Fig. 4, Inactive auto Finance Customer Base (120)).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include selling to inactive customer base of Melchione et al. because Nabe et al. teach including above features enables one or more inactive customer respond to offer to sell (Nabe et al., column 1, lines 34-35).

26. As per claim 28, Jones et al. in view of Walker et al. teach claim 27 as described above. Jones et al. further teach the method wherein

the customer response accepts the new bank account associated with the dead bank card, and wherein the processing comprises funding the new bank account (see Fig. 5A; Fig. 5C, step 272 and 274).

27. As per claim 29, Jones et al. in view of Walker et al. teach claim 28 as described above. Jones et al. further teach the method wherein

the funding is from a customer-supplied source of funds (Fig. 5c, step 274; paragraph [0091]).

28. As per claim 30, Jones et al. in view of Walker et al. teach claim 28 as described above. Jones et al. further teach the method wherein

the funding is from the credit account associated with the live credit card distributed with the dead bank card (Fig. 5c, step 274; paragraph [0091]).

29. As per claim 31, Jones et al. in view of Walker et al. teach claim 28 as described above. Jones et al. further teach the method wherein

the funding is an incentive deposit provided by the bank to incentivize the customer to accept the new bank account (see Fig. 5C, steps 282-290; paragraph [0088]), [0095]).

30. As per claim 32, Jones et al. in view of Walker et al. teach claim 27 as described above. Jones et al. further teach the method wherein
the credit card and the bank card are linked through a reward or rebate program
(see paragraph [0090], [0091]).

31. *Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Melchione et al. U.S. Patent No. 5,930,764 (reference A in attached PTO-892) in view of Strock et al., U.S. Pub No. 2004/0122736 (reference E in attached PTO-892).*

32. As per claim 23, Melchione et al. teach claim 21 as described above.

Melchione et al. do not teach the method comprising the step of providing an incentive to a customer who is not an existing bank account holder, a first incentive being provided to a customer who is not an existing bank account holder and who is not a past bank account holder, and a second incentive being provided to a customer who is not an existing bank account holder and who is a past bank account holder, thereby providing different incentives to new bank account customers and past bank account customers.

Strock et al. teach the method comprising the step of providing an incentive to a customer who is not an existing bank account holder, a first incentive being provided to a customer who is not an existing bank account holder and who is not a past bank account holder, and a second incentive being provided to a customer who is not an existing bank account holder and who is a past bank account holder, thereby providing different incentives to new bank account customers and past bank account customers

(Strock et al., Fig. 3B; paragraph [0010].

Therefore, it would be *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to include providing an incentive to a customer who is not an existing bank account holder, a first incentive being provided to a customer who is not an existing bank account holder and who is not a past bank account holder, and a second incentive being provided to a customer who is not an existing bank account holder and who is a past bank account holder, thereby providing different incentives to new bank account customers and past bank account customers of Melchione et al. because Strock et al. teach including above features enables to encourage certain customer behavior, strengthen relationship between Bank and customers, and attract and retain loyal customers (Strock et al., paragraph [0003] and [0004]).

33. *Claim 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. U.S. Pub No. 2004/0117300 (reference C in attached PTO-892) in view of Strock et al., U.S. Pub No. 2004/0122736 (reference E in attached PTO-892).*

34. As per claim 33-34 and 36, Jones et al. teach providing promotion based on activation of the card.

Jones et al. do not teach offering reward or rebated based on credit card usage.

Strock et al. teach offering reward or rebated based on credit card usage (Strock et al., paragraph [0010]).

Therefore, it would be *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to include offering reward or rebated based on credit card

usage of Jones et al. because Strock et al. teach including above features enables to encourage certain customer behavior, strengthen relationship between bank and customers, and attract and retain loyal customers (Strock et al., paragraph [0003] and [0004]).

35. As per claim 35, Jones et al. teach claim 33 as described above. Jones et al. further teach the method, wherein

offering different levels of incentive to the customer to use the credit card and the bank card (see paragraph [0095] and [0096]).

Jones et al. do not teach the first rewards or rebates and the second rewards or rebates are different.

Strock et al. teach the first rewards or rebates and the second rewards or rebates are different (Strock et al., paragraph [0010]).

Therefore, it would be *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to include first rewards or rebates and the second rewards or rebates are different of Jones et al. because Strock et al. teach including above features enables to encourage certain customer behavior, strengthen relationship between bank and customers, and attract and retain loyal customers (Strock et al., paragraph [0003] and [0004]).

36. As per claim 36, Jones et al. teach claim 27 as described above.

Jones et al. further teach the method, wherein

the bank provides the customer an incentive deposit of rewards or rebates to accept the new bank account associated with the dead bank card (see paragraph [0095] and [0096]).

Jones et al. do not teach the credit card is a cobranded credit card offering first rewards or rebates based on credit card usage.

Strock et al. teach the credit card is a cobranded credit card offering first rewards or rebates based on credit card usage (Strock et al., paragraph [0010]).

Therefore, it would be *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to include offering first rewards or rebates based on credit card usage of Jones et al. because Strock et al. teach including above features enables to encourage certain customer behavior, strengthen relationship between bank and customers, and attract and retain loyal customers (Strock et al., paragraph [0003] and [0004]).

Response to Arguments

37. After careful consideration of applicant's arguments and amendments, new grounds of rejection of claims necessitated by applicant amendments are established in the instant application. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Examiner reiterates, as in previous prosecution that it disagrees with applicant argument that claimed invention does not require permission from a consumer before sending a card. The written description specifically submits "The dead bank card 618

relates to a separate card/account proposed by the bank as a result of the customer's application for a credit account" (page 18, lines 1-3). Further the shortcomings as cited by Applicant is supplemented by Walker et al which teaches issuance of unsolicited inactive card requiring customer approval to activate the account (see abstract).

The Examiner further directs applicant attention to missing support of "inactive deposit account" in the written description. The best related phrase in the written description are "bank account that was previously closed with that bank" (page 3, lines 13-14), "past bank account" (Fig. 2, 214; page 11, line 10).

Conclusion

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosures. The following are pertinent to current invention, though not relied upon:

Buchanan et al. (U.S. Patent No. 5,950,179) teach method and system for issuing a secured credit card product.

Christiansen et al. (U.S. Patent No. 6,202,053) teach method and apparatus for generating segmentation scorecards for evaluating credit risk of bank card applicants.

Hall, III et al. (U.S. Patent No. 6,158,657) teach system and method for offering and providing secured.

Kishen et al. (U.S. Pub No. 2004/0103065) teach systems and method for soliciting customers using computer readable media.

Matada (U.S. Patent No. 6,817,521) teaches credit application automation system.

Mobed et al. (U.S. Patent No. 7,103,573) teach user rewards program and communication system.

Nabe et al. (U.S. Pub No. 2002/0194050) teaches methods and systems for supplying customer leads to dealers.

Rubio et al. (U.S. Pub No. 2002/0062241) teach apparatus and method for coding electronic direct marketing lists to common searchable format.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bijendra K. Shrestha whose telephone number is (571) 270-1374. The examiner can normally be reached on 8:00AM-4:30 PM(Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bijendra K. Shrestha/
Examiner, Art Unit 3691
07/04/2010